



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,561	04/16/2001	Olga Bandman	PF-0333-2 DIV	8070

27904            7590            08/19/2002  
INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO, CA 94304

[REDACTED] EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 08/19/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/836,561	BANDMAN ET AL.	
	Examiner Sheela J Huff	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 June 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 41-66 is/are pending in the application.

4a) Of the above claim(s) 43,44 and 47-66 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 41 and 45 is/are rejected.

7) Claim(s) 42 and 46 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 16 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I, claims 41-42 and 45-46 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the methods of making the polypeptide should be rejoined with the polypeptide, that the polynucleotides would possess no additional burden since they are already part of an issued patent and that the search for Group I would overlap with Group V. This is not found persuasive because rejoinder will be considered upon allowance of the polypeptide claims. Applicant should also note that similar method claims have already been allowed (see claim 7 of 5872234). The search for the polypeptides would not overlap with the search for antibodies because they are found in different subclasses and are patentable distinct.

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

The IDS filed 4/16/01 has been considered. An initialed copy of the PTO-1449 is enclosed.

***Claim Rejections - 35 USC § 112***

Claims 41 and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polypeptides having at least 85% identity with SEQ ID NO 1. While the amino acid sequence of SEQ ID NO:1 is adequately described in the specification as-filed, thereby providing an adequate basis for the polypeptide of SEQ ID NO:1; there is insufficient written description as to the identity of a polypeptide having at least 85-99% sequence identity to SEQ ID NO:1 that would still maintain the function of the polypeptide. Consequently, the specification does not provide an adequate written description of a polypeptide having at least 85-99% sequence identity to SEQ ID NO:1.

The specification as filed does not provide adequate written description support for a polypeptide having at least 85-99% sequence identity to SEQ ID NO:1.

Polypeptides having diverse functions are encompassed by the phrase 85-99% identity. Thus a broad genus having potentially highly diverse functions is encompassed by the phrase 85-99% sequence identity" and conception cannot be achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method. For example, Skolnick et al. (Trends in Biotech., 18(1):34-39, 2000) teach that the skilled artisan is well aware that assigning functional activities for any particular protein or protein family based upon sequence homology is inaccurate, in part because of the multifunctional nature of proteins (e.g., "Abstract" and "Sequence-based approaches to function prediction", page 34). Even in situations where there is some confidence of a similar overall structure between two proteins, only experimental research can confirm the artisan's best guess as to the function of the structurally related protein (see in particular "Abstract" and Box 2). Adequate written description requires more than a

mere statement that it is part of the invention. The sequence itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016.

Therefore, only SEQ ID No. 1 meets the written description provision of 35 U.S.C. 112, first paragraph. Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the written description inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.). Consequently, Applicant was not in possession of the instant claimed invention. See University of California v. Eli Lilly and Co. 43 USPQ2d 1398.

Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

Claims 41 and 45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO. 1, does not reasonably provide enablement for biologically active or immunogenic fragments of SEQ ID No. 1 or naturally-occurring sequences with at least 85% identity to SEQ ID No. 1. The specification does not enable any person skilled in the art to which it pertains, or with

Art Unit: 1642

which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of proteins broadly encompassed by the claims and the claims broadly encompass a significant number of inoperative species. Since the amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's amino acid sequence and still retain similar biological activity requires a (1) knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e., expectantly intolerant to modification), and (2) detailed knowledge of the ways in which the protein's structure relates to its function. However, the problem of predicting protein structure from mere sequence data of a single protein and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein and finally what changes can be tolerated with respect thereto is extremely complex and well outside the realm of routine experimentation.

Art Unit: 1642

1. While recombinant and mutagenesis techniques are known, it is not routine in the art to screen for multiple substitutions or multiple modifications of other types and the positions within the protein's sequence where amino acid modifications can be made with a reasonable expectation of success in obtaining similar biological activity are limited in any protein. The result of such modifications is unpredictable based on the instant disclosure. One skilled in the art would expect any tolerance to modification shown for a given protein to diminish with each further and additional modification, e.g., multiple substitutions. The sequence of some proteins is highly conserved and one skilled in the art would not expect tolerance to any amino acids modifications in such proteins.

2. The specification does not support the broad scope of the claims which encompass all modifications and fragments because the specification does not disclose the following:

1. The general tolerance to modification and extent of such tolerance;
2. The specific positions and regions of the sequence(s) which can be predictably modified and which regions are critical;
3. What fragments, if any, can be made which retain the biological activity of the intact protein or what the immunogenic fragments can be used for and what the antibodies directed against the immunogenic fragments can be used for; and
4. The specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

3. Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed protein in manner reasonable correlated with the scope of the claims broadly including any number of additions, deletions, or substitutions and fragments of any size. The scope of the claims must bear a reasonable correlation with the scope of enablement. See *In re Fisher*, 166 USPQ 19 24 (CCPA 1970). Without such guidance, the changes which can be made in the protein's structure and still maintain biological activity is unpredictable and the experimentation left to those skilled in the art is unnecessarily and improperly extensive and undue. See *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ 1016 (Fed. Cir. 1991) at 18 USPQ 1026 1027 and *Ex parte Forman*, 230 USPQ 546 (BPAI 1986).

***Allowable Subject Matter***

Claims 42 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-7866. The examiner can normally be reached on M,Th 5:30 am-2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*Sheela J Huff*  
Sheela J Huff  
Primary Examiner  
Art Unit 1642

sjh  
August 15, 2002